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10/674,643	09/30/2003	Stephen H. Roby	T-6172 (538-52)	4801
<div>7590 12/04/2007</div> <div>Michael E. Carmen, Esq. M. CARMEN & ASSOCIATES, PLLC Suite 400 170 Old Country Road Mineola, NY 11501</div> <div>EXAMINER ANTHONY, JOSEPH DAVID</div> <div>ART UNIT PAPER NUMBER</div> <div>1796</div> <div>MAIL DATE DELIVERY MODE</div> <div>12/04/2007 PAPER</div>				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/674,643
Filing Date: September 30, 2003
Appellant(s): ROBY ET AL.

MAILED
DEC 04 2007
GROUP 1701

Michael E. Carmen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/03/2007 appealing from the Office action mailed 11/30/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,278,006	KODALI et al.	08-2001
5,338,471	LAI	08-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11, 15, 18-22, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. teach oils containing transesterified reaction products of triacylglycerol polyol ester, such as **IMC-130 canola oil** with a non-glycerol polyol ester, such as **trimethylolpropane triheptanoate (i.e. TMPTH)**, as well as methods of making such. Methods for improving lubrication properties of a vegetable oil also are described see abstract, see abstract and column 5, line 20 to column 7, line 18 with special emphasis on column 6, lines 16-31. Please note that **unreacted** triacylglycerol polyol esters, such as IMC-130 canola oil, are deemed to read on applicant's claimed "base oil of lubricating viscosity" (i.e. component (a)), **wherein the transesterified reaction product** of triacylglycerol polyol ester with a non-glycerol polyol ester are deemed to read on applicant's component (b). Applicant's claims are deemed to be anticipated over the Example 4 wherein a model is constructed for the transesterification of IMC-130 canola oil and TMPTH as shown in FIG. 3. A review of FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15 wt.%), the concentration of the **transesterified reaction product** of IMC-130 canola oil and TMPTH is in a **minor amount** compared to the concentration of the **unreacted** IMC-130 canola oil which would be in a **major amount**. Under said circumstances, applicant's

claims are deemed to be clearly anticipated. Please note that applicant's own specification clearly discloses that applicant's component (a) a base oil of lubricating viscosity can be selected from "natural lubricating oils, synthetic lubricating oils and mixtures thereof". Applicant's specification further discloses that: "Useful natural oils include **vegetable oils** (e.g. rapeseed oils, castor oils and lard oil)", see page 11, lines 8-9 and page 11, lines 18-21 of applicant's specification. As such, Kodali et al's **unreacted** triacylglycerol polyol esters, such as IMC-130 **canola oil**, clearly reads on applicant's component (a) which is a base oil of lubricating viscosity.

Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. has been described above and is deemed to anticipated applicant's claimed invention for the reasons set forth above. In the alternative, Kodali et al. may differ from applicant's claimed invention in that it is unclear if there is a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration ranges. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since such directly falls within the disclosure of Kodali et al.'s Example 4 wherein a model is constructed for the transesterification of IMC-130 canola oil and TMPH as shown in FIG. 3. A review of

FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15 wt.%), the concentration of the transesterified reaction product of IMC-130 canola Oil and TMPTH is in a minor amount compared to the concentration of the unreacted IMC-130 canola oil which would be in a major amount.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lal U.S. Patent Number 5,338,471 in view Kodali et al. U.S. Patent Number 6,278,006.

Lal teaches a composition containing the combination of:

(A) at least one vegetable or synthetic triglyceride, (B) esters from the transesterification of at least one animal or vegetable oil triglyceride, (C) a pour point depressant, and (D) a performance additive. **The composition may optionally contain (E) other oils (such as, synthetic ester base oil, mineral oils, polyalpha olefins oil and vegetable oil)**, see the abstract and especially column 50, line 61 to column 53, line 67 for the disclosure of oils that can be used as component (E). Lal differs from applicant's lubricating oil composition in that Lal component "(B) esters from the transesterification of at least one animal or vegetable oil triglyceride" appear to be different from applicant's claimed component (b) because Lal transesterfying process is different from applicant's transesterfying process.

Kodali et al. has all been described above.

It would have been obvious to one having ordinary skill in the art to use the direct teaching of the secondary reference to Kodali et al. as strong motivation to actually use Kodali et al.'s transesterified product in lieu of or in addition to the transesterified

products directly disclosed by Lai for the benefits that these oxidative stable transesterfied products are taught to have. To use the transesterfied products, as taught by the Kodali et al. secondary reference, within all of applicant's claimed concentration ranges, is also deemed to be obvious since the secondary reference to Kodali et al. directly discloses these concentration ranges, including those of dependent claims 13-14 and 24-25 (when very low concentrations of TMPTH reactant are used in the transesterifying reaction), see Example 4 wherein a model is constructed for the transesterification of IMC-130 canola oil and TMPTH as shown in FIG. 3.

(10) Response to Argument

On page 8, lines 8-10 of applicant's Appeal Brief, applicant makes the following statement about Example 4 of the applied Kodail et al. patent: "Any unreacted components resulting from the reaction of IMC 130 oil and TMPTH *would merely be a part of the reaction product as recited in the claim* and not the major amount of a base oil of lubricating viscosity as alleged by the Examiner.". In response, the Examiner holds that applicant's claims are deemed to be anticipated over the Example 4 wherein a model is constructed for the transesterification of IMC-130 canola oil and TMPTH as shown in FIG. 3. A review of FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15 wt.%), the concentration of the **transesterfied reaction product** of IMC-130 canola oil and TMPTH, is in a minor amount compared to the concentration of the **unreacted** IMC-130 canola oil which would be in a major

amount. Under said circumstances, applicant's claims are deemed to be clearly anticipated.

Furthermore in response to applicant's said quote, the Examiner wholly disagrees with applicant's contention that the unreacted IMC 130 canola oil would not read on applicant's major amount of a base oil of lubricating viscosity as alleged by the Examiner. As pointed out previously, applicant's own specification clearly teaches that that applicant's component (a), a base oil of lubricating viscosity, can be selected from "natural lubricating oils, synthetic lubricating oils and mixtures thereof". Applicant's specification further discloses that: "Useful natural oils include **vegetable oils** (e.g. rapeseed oils, castor oils and lard oil)", see page 11, lines 8-9 and page 11, lines 18-21 of applicant's specification. Since, Kodali et al's unreacted IMC-130 **canola oil** of Example 4 as shown in FIG. 3, is a vegetable oil, and vegetable oils are taught by applicant to be within applicant's claimed component (a), applicant's said contention is deemed by the Examiner to be mistaken.

In the bridging paragraph on pages 6-7 of applicant's Appeal Brief, applicant makes the following statement: "In contrast to the presently claimed invention Kodali et al discloses base oils prepared by transesterfying a first glycerol polyol ester with a second non-glycerol polyol ester which can be formulated with about 0.001% to about 20%, based on weight, of one or more additives. Thus, the transesterfied oil product disclosed in Kodali et al. is used in a major amount together with a minor amount (i.e. about 0.001% to about 20%, based on weight) of one or more additives such as antioxidants, anti-foams, anti-wear additives, corrosion inhibitors, dispersants, detergent

and acid neutralizers." In response the Examiner, wants to point out that the unreacted IMC-130 **canola oil** of Example 4 as shown in FIG. 3, remains the major part of the resulting composition comprising the reaction product of IMC-130 **canola oil** with TMPTH reactant. The fact that it is possible in Kodali et al. invention to subsequently, incorporate minor amount (i.e. about 0.001% to about 20%, based on weight) of one or more additives to said reaction product is irrelevant. In fact, applicant's own specification allows for the incorporation of these same types of additives to applicant's claimed compositions, see pages 22-45 of applicant's specification.

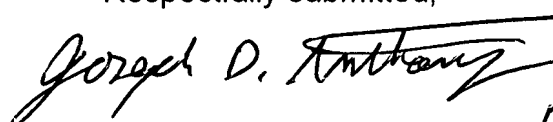
Finally, the examiner holds that the Examiner made prior-art rejection of applicant's claims over Lai in view of Kodali et al is deemed to be clearly proper for the reasons set forth in the above prior-art rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Joseph D. Anthony 11/29/07

Conferees:


Romulo Delmendo
Appeal Continue


Harold Pyon
SPE 1796